

REMARKS

In response to the above-identified Office Action, Applicants amend the application and seek reconsideration thereof. In this response, Applicants amend Claims 1, 5, and 9. Applicants do not cancel or add any claims. Accordingly, Claims 1-12 are pending.

I. Claims Rejected Under 35 U.S.C. §102

The Patent Office rejects Claims 5, 6 and 9-11 under 35 U.S.C. 102(a) as being anticipated by International Publication No. WO99/05734 to Takeuchi, et al. ("Takeuchi").

Applicants first note that the 37 C.F.R. 1.131 Declarations submitted on May 27, 2003, to overcome the rejection based on Takeuchi do present sufficient evidence to predate Takeuchi. In response to Applicants' submission of the 37 C.F.R. 1.131 Declarations, the Patent Office states that these Declarations are insufficient to establish conception of the invention prior to the effective date of the cited references, noting particular compounds and elements recited in Applicants' independent Claims 1, 5, and 9 that were not disclosed in the translation of the Korean Invention Report referred to in the 37 C.F.R. 1.131 Declaration.

In response, Applicants note that neither the MPEP nor the case law pertaining to 37 C.F.R. 1.131 Declarations requires that every single element of Applicants' claim be disclosed in the priority document (e.g., the Korean Invention Report for the present application). Specifically, in In re Stempel it was held that "all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show. When he has done that he has disposed of the reference." 241 F.2d 755, 759 (C.C.P.A. 1957). Thus, the priority document must merely disclose that the inventor had prior possession of the specific portions of the claims upon which the Patent Office bases the rejection. Specifically, each of the compounds and elements relied upon by the Patent Office to show that Applicants' Declarations are insufficient are not disclosed by the references upon which the Patent Office bases the rejection. Therefore, Applicants submit that the previously submitted 1.131 Declarations are sufficient to overcome Takeuchi.

Accordingly, Applicants respectfully request withdrawal of the rejection of amended independent Claims 5 and 9. Claims 6, 10, and 11 depend from independent Claims 5 and 9, respectively. The rejected dependent claims are not anticipated at least for the same reasons as their respective independent claims.

The Patent Office rejects Claims 9 and 11 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,428,766 to Fujino, et al. ("Fujino").

Similar to Takeuchi, discussed above, the Patent Office states that the previously submitted 1.131 Declarations are insufficient to overcome Fujino. In response, Applicants submit that the same arguments set forth above pertaining to Takeuchi apply equally here to Fujino. Specifically, the elements and compounds that the Patent Office states as being absent from Applicants' priority document are not disclosed by Fujino. Therefore, Applicants submit that the evidence submitted along with the 1.131 Declarations is sufficient to overcome the Fujino reference, as relied upon by the Patent Office.

Accordingly, Applicants respectfully request withdrawal of the rejection of Claims 9 and 11.

The Patent Office rejects Claims 9-12 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,365,299 to Miyaki, et al. ("Miyaki").

In making the rejection, the Patent Office relies on Miyaki to show a non-aqueous secondary battery comprising a positive electrode and a negative electrode both containing a material capable of reversibly intercalating and deintercalating lithium. A protective layer is provided on the negative electrode and/or the positive electrode. The protective layer can be formed successively or simultaneously by applying an electrode material mixture onto a current collector (Col. 6, lines 47-50).

In response, Applicants submit that Miyaki, similar to Miyasaka discussed below, does not teach or suggest the structure recited in Applicants' amended independent Claim 9, which has unexpected superior performance characteristics due to the manner in which the electrode is created. Specifically, the electrode recited in Applicants' independent Claim 9 recites that the active

material particles are coated with a metallic oxide and then the positive electrode is formed from the coated particles. The 37 C.F.R. 1.132 Declaration submitted herewith demonstrates that devices constructed according to the currently pending independent claims have unexpected superior performance characteristics relative to devices constructed in a manner similar to that discussed in Miyaki (e.g., where individual particles are not coated prior to forming an electrode from the coated particles) and the Miyasaka reference discussed below. Thus, Miyaki does not disclose the structure or methodology recited in Applicants' amended independent Claim 9, and therefore, devices constructed according to the Miyaki reference cannot realize the superior characteristics that result from constructing a device as recited in Applicants' amended independent Claim 9.

Accordingly, Applicants respectfully request withdrawal of the rejection of amended independent Claim 9. Claims 10-12 depend from Claim 9 and are not anticipated at least for the same reasons.

II. Claims Rejected Under 35 U.S.C. §103(a)

The Patent Office rejects Claims 1-4, 7, 8, and 12 under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,674,645 to Amatucci, et al. ("Amatucci") in view of Takeuchi.

In order to render a claim obvious, the relied upon references must teach or suggest every limitation of the claim such that the invention as a whole would have been obvious at the time the invention was made to one skilled in the art.

In making the rejection, the Patent Office relies on Amatucci to show a lithium ion rechargeable battery having a lithium manganese oxy-fluoride positive electrode material, noting that Amatucci does not teach that the lithium manganese oxy-fluoride positive electrode material is coated with a metallic oxide. The Patent Office relies on Takeuchi to cure this deficiency of Amatucci.

In response, Applicants reiterate that Takeuchi cannot be properly cited against the currently pending claims since the 1.131 Declarations discussed above show possession of the subject matter relied upon in Takeuchi prior to the effective date of Takeuchi as a reference against the

claims of the current application. Therefore, without Takeuchi, Amatucci cannot sustain the current rejection.

Accordingly, Applicants respectfully request withdrawal of the rejection of Claims 1-4, 7, 8 and 12.

The Patent Office rejects Claims 1-4 under 35 U.S.C. 103(a) as being obvious over Amatucci in view of U.S. Patent No. 5,869,208 to Miyasaka ("Miyasaka").

In making the rejection, the Examiner relies on Amatucci to show a lithium ion rechargeable battery having a lithium manganese oxy-fluoride positive electrode material, acknowledging that Amatucci does not teach that the lithium manganese oxy-fluoride positive electrode material is coated with a metallic oxide. The Patent Office relies on Miyasaka to cure this deficiency of Amatucci.

In response, Applicants submit herewith Declarations pursuant to 37 C.F.R. § 1.132 to demonstrate that an experiment conducted to compare the performance characteristics of the metallic oxide coating applied, as discussed in Miyasaka, with a metallic oxide coating applied as recited in Applicants' amended independent claims. Exhibit A of the attached Declarations shows that the method, and necessarily the different structure, of the currently pending independent claims has unexpected superior performance characteristics relative to a device constructed according to the teachings of Miyasaka.

Accordingly, Applicants respectfully request withdrawal of the rejection of Claims 1-4.

CONCLUSION

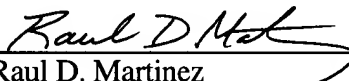
In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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Dated: 12/9, 2003


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CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 9, 2003.


Lillian E. Rodriguez

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